

Remarks

The final Office action dated March 25, 2008 has been carefully reviewed and considered.

Applicants request reconsideration for the following reasons.

35 U.S.C. § 112 Rejection

Claim 17 was rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. While Applicants respectfully disagree with the Examiner's reasoning, claim 17 has been canceled, thus rendering this rejection moot.

35 U.S.C. § 102 Rejections

Claims 1, 4-7, 15, 16, and 18 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Saitamakiki. Applicants respectfully traverse the rejection and submit a Declaration under 37 C.F.R. § 1.132 from Tobias Hülsen, an expert in the field. Mr. Hülsen is an Application engineer at NMB-Minebea GmH, a wholly owned subsidiary of Minebea Co. Ltd., which is the assignee of the present application. Mr. Hülsen was not specifically involved in the present application.

Applicants recognize that the patentability of a product does not depend on its method of production. However, Applicants do not suggest that the claimed bearing arrangements are patentable merely because they are produced by a different method than that disclosed in Saitamakiki. Rather, Applicants argue that the different method used in Saitamakiki to assemble its ball joint produces a device that is much different than the claimed bearing arrangements, and the different methods of assembly provide evidence that Saitamakiki's device inherently does not possess the same characteristics as the claimed bearing arrangements.

The Office action alleges on page 3 that "the 'predetermined range' of torque of claim 1 is inherently 'non-zero' and is anticipated by the arrangement of Saitamakiki." The accompanying

Declaration is evidence that one having ordinary skill in the art would not interpret the ball joint of Saitamakiki as having a non-zero torque before being installed in an interference fit hole, as required by claim 1. *See* ¶ 5-9 of the Declaration. In other words, one having ordinary skill in the art would interpret the arrangement of Saitamakiki, based on the disclosed structure and method of production, as having zero torque between the spherical ended shaft 6 and the housing. *Id.* Thus, Applicants respectfully submit that the Examiner's presumption that the arrangement of Saitamakiki has a non-zero torque prior to installation in an interference fit hole has been overcome.

The Office action rejects Applicants' prior arguments that some small gap must exist between the ball 6 and bearing housing 9 or between ball 6 and bearing block 7 of Saitamakiki to allow for lubricating material because the "allegations are unsupported by any evidence." Office action at page 4. Applicants herewith submit evidence to this effect at, for example, ¶ 9 of the Declaration, which states that "to use lubricant will require a gap between the bearing surfaces, which gap causes zero torque." Furthermore, one of ordinary skill in the art would recognize that liquid lubricant is incompatible with bearings that require high torque. *See* ¶ 9 of the Declaration.

The Office action also alleges that "the description in Saitamakiki with respect to the check ring does nothing to suggest anything other than that it retains the bearing block in the housing." Office action at page 4. With respect, if the bearing block fit tightly around the spherical ended shaft 6 within the housing 9, a check ring would not be necessary to retain the bearing block in the housing. The presence of the check ring suggests that zero torque exists between the spherical ended shaft 6 and the housing 9 in Saitamakiki. The Declaration states that "it is clear to me that there are no forces imparted on the two-part bearing block 7 and spherical ended shaft 6 by the housing 9, else there would be no need for a check ring to retain the articles therein." *See* ¶ 7 of the Declaration.

In sum, the device disclosed in Saitamakiki has zero torque prior to being installed in an interference fit hole, as evidenced by the presence of a check ring, a lubricant, and the two part

construction of the bearing block. Thus, the arrangement disclosed in Saitamakiki does not teach, or even suggest, the bearing arrangement of claim 1. Because Saitamakiki does not teach every element of claim 1, the reference cannot teach every element of claims 4-7, 15, 16, or 18 because these claims depend from claim 1 and each recite a patentably distinct combination of features. Accordingly, Applicants respectfully request that these rejections be withdrawn.

35 U.S.C. § 103 Rejections

Claims 2, 3, and 12-14 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Saitamakiki. Claims 2, 3, and 12-14 depend from claim 1. Because, as discussed above, Saitamakiki does not teach or suggest all the elements of claim 1, Saitamakiki cannot teach or suggest each element of claims 2, 3, or 12-14. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Conclusion

Applicants submit that the evidence presented in the Declaration, along with the arguments submitted herein are sufficient to overcome the burden placed on Applicants to prove that Saitamakiki's device does not inherently have a non-zero torque before installation into an interference fit hole. Accordingly, this application should be in condition for allowance. Should any questions remain in this application, Examiner Hannon is invited to contact the undersigned attorney at the telephone number below.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By /Amy B. Durocher/
Amy B. Durocher
Registration No. 62,065